REMARKS

SECTION 112 REJECTIONS

The office action rejected claims 36-41 under 35 USC 112 (first paragraph), arguing that the claimed "**selection indicator**" is not adequately described in the specification. The office action rejected claims 36-41 under 35 USC 112 (second paragraph) for a similar reason. On both counts, we respectfully disagree. The application explicitly discusses the user of checkmarks and pushpins, with ref. 34 (Fig. 3) being one example. The application also explicitly mentions a depressed pin graphic or color denotation. Moreover, the application specifically recognizes that those skilled in the art (having the benefit of this disclosure) will appreciate that other indicia may be used to designate sites of interest, and that other gestures may be employed by the user to select those sites of interest.

If the office action seeks explicit mention of the term "selection indicator" in the specification, this view is unwarranted. Indeed, the failure to provide explicit antecedent basis for the terms does not always render a claim indefinite. MPEP 2173.05(e). If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. Bose Corp. v. JBL, Inc., 274 F.3d 1354, 1359 (Fed. Cir. 2001). Moreover, an antecedent basis can be present by implication. Slimfold Manufacturing Co. v. Kinkead Industries, Inc., 810 F.2d 1113, 1116 (Fed. Cir. 1987).

When the meaning of the claim would reasonably be understood by persons of ordinary skill when read in light of the specification, the claim is not subject to invalidity upon departure from the protocol of "antecedent basis." Energizer Holdings, Inc. v. ITC, Cast No. 05-1018 (Fed. Cir. 2006). The definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification. Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692 (Fed. Cir. 2001).

The office action does not provide a persuasive argument that defects of

claims 36-41 rise to sufficient magnitude that ordinarily skilled artisans could not reasonably ascertain the claim scope. Indeed, we submit that ordinarily skilled artisans could reasonably ascertain the claim scope without difficulty.

The office action also rejected claims 36 and 40-41 under section 112, alleging that the limitation "**search results**" lacks antecedent basis in the claims. We respectfully disagree. We checked each instance of "search results," and did not uncover any with antecedent problems. We kindly request a more specific explanation of why these terms might be problematic.

SECTION 101 REJECTIONS

The office action rejected claims 36-41 under 35 USC 101, proposing that the claims' use of a computer or hardware was unclear. Claims 36-40 (as amended) satisfy section 101. Claim 41 (as is) satisfies section 101, since the claim explicitly recites a computer driven search apparatus.

SECTION 103 REJECTIONS

The office action rejected claims 36-37 and 40-41 under 35 USC 103 as being obvious over the proposed Hoch-Ehrlich combination. We politely but firmly disagree. In short, the claims are patentably distinguished from the applied art for a number of reasons.

Taking claim 36 as an example, the office action suggested that Hoch's step 603 (Fig. 6) teaches "**in response to receiving a user selection of one or more of the selection indicators, saving in association with the query any search results associated with the selected selection indicators and discarding any search results unassociated with the selected selection indicators.**" We disagree, for a number of reasons. First, Hoch does not disclose any selection indicators. Second, Hoch does not teach saving certain search results and discarding other search results in response to any user action.

Although Hoch mentions a user's request to search for songs, the search results are filtered automatically based on the user's "persona." The persona is said to include genres, interests, personal preferences, and the like. Moreover,

filtering (based on this persona) is done automatically using a learning mechanism such as a genetic algorithm or a neural network algorithm. Hoch does not contemplate that the song filtering is conducted "in response to receiving a user selection of one or more of the selection indicators..." as claimed. Indeed, the fact that Hoch's filtering is based on automatic learning mechanism is central to Hoch's disclosure, and permeates Hoch's Title, Abstract, Field of the Invention, Summary, and the remainder of Hoch's disclosure. Indeed, Hoch touts the benefit of such automatic filtering, which enables searches to become "more adapted to the user's interests, as well as, becoming more fine grained as new levels of parameters are used to search."

The office action further suggested that Hoch's step 604 (Fig. 6) teaches **"subsequent to receiving the user selection of the one or more of the selection indicators, receiving a user request including at least an identification of the query."** We disagree. Hoch recites step 604 as follows: "generate a search result based on the filtered information." This has nothing to do with any user request. Rather, this step is implemented by a machine such as Hoch's "digital processing system" (Fig. 2) without involving any component of user action.

Apart from step 604, Hoch does mention a step (606) of receiving a selection of at least a portion of the search result from the display. But this does not include "at least an identification of the query." Rather than identifying the query, this is the start of new query where the user selects an area from the displayed search results, such as the area 305, in order to initiate a new search to retrieve relevant information from the peers related to the selected "area." When the user selects area 305, for example, the search conducts a search and filters the information collected from the peers based on persona information of the user as well as the user's past preferences or behaviors collected by the learning mechanism. Thus, there is nothing in Hoch to show "receiving a user request including at least an identification of the query."

The office action further suggested that Hoch's step 606 (Fig. 6) satisfies the claimed feature **"in response to receiving the user request, conducting a**

new search according to said query and presenting the user with the following items in association with each other: a set of new search results satisfying the query, and the original set of search results saved in association with the query." However, Hoch does not conduct a new search according to the (original) query, as claimed. Rather, Hoch's user selects of a portion of the search result from the display (step 606), and then based on this, Hoch searches for content (step 602). This search is not conducted "according to said query" as required by the claim. Presumably, the original query is discarded. Furthermore, Hoch does not present "new search results" and the "original seat of search results." Nowhere does Hoch demonstrate any concern for supplementing the original query. Rather, Hoch seeks to refine the search "until the user is satisfied with the results." Indeed, Hoch's user selects an area from the search <u>results</u> (such as area 305), at which point another search is conducted to retrieve relevant information from the peers related to the selected area.

The office action admitted that Hoch lacks the following feature, but suggested that it is found in Ehrlich: "**in response to receiving the query, conducting a search according to the query and presenting an original set of search results to the user, wherein each search result in the original set is presented in association with a selection indicator that is selectable by the user to save the associated search result.**" However, in one sense, Hoch already has an mechanism (inconsistent with Ehrlich) to present search results to the user (e.g., the display 302 of Fig. 3, with various nodes 303, 304, 305 associated with contents in a geographical visualized manner). And, Hoch displays these nodes (e.g., 305) for selection by the user, but rather than saving the associated search result, these nodes serve to execute a different search, as discussed in detail above. Indeed, Hoch explicitly describes that the user may select one of these areas, such as area 305, to begin another search and retrieve relevant information from the peers related to the selected area. Therefore, it appears that the suggested feature of Ehrlich is not only inconsistent with Hoch, but this would change the Hoch's principle of operation. There would

not be any reason for an ordinarily skilled artisan to incorporate the stated feature of Ehrlich into Hoch, as the Examiner proposed.

The office action suggested that "[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hoch by the teaching of Ehrlich et al." for the following reason:

> ...in response to receiving the query, conducting a search according to the query and presenting an original set of search results to the user, wherein each search result in the original set is presented in association with a selection indicator that is selectable by the user to save the associated search result, would enable the method because, "A typical search engine has an interface with a search window where the shopper enters an alphanumeric search expression or keywords. The search engine sifts through available web sites for the shopper's search terms, and returns the search of results in the form of HTML pages. Each search result includes a list of individual entries that have been identified by the search engine as satisfying the shopper's search expression. Each entry or "hit" may include a hyperlink that points to a Uniform Resource Locator (URL) location or web page", (see paragraph 5).

We confess that we do not understand the meaning of this statement. Consequently, we cannot evaluate the Examiner's reasoning. Nevertheless, it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. MPEP 706.02(j).

We further submit that the proposal for combining Hoch/Ehrlich as stated in the office action is incomplete because it does not resolve or define the person of ordinary skill in the art. It is mere speculation to suggest what would have been obvious to a person of ordinary skill in the art if this standard has not been resolved or at least discussed.

At any rate, we submit that the proposed Hoch/Ehrlich combination is

improper because there is no persuasive reason for ordinarily skilled artisan to have combined the references.

Accordingly, independent claim 36 is patentably defined over Hoch-Ehrlich. And, independent claims 40-41 are patentable for similar reasons. Even without addressing the individual merits of claim 37, this claim is patentably distinguished over Hoch-Ehrlich by virtue of its dependence on claim 36.

The office action rejected claims 38-39 under 35 USC 103 as being obvious over the proposed Hoch-Ehrlich-Bowen combination. Even without addressing the individual merits of claims 38-39, however, these claims are patentably distinguished over Hoch-Ehrlich-Bowen by virtue of their dependence on claim 36.

NEW CLAIM

We added claim 42 to the application to emphasize operations including, in response to receiving the user request, conducting a new search according to said first query and presenting the user with the following items in association with each other: a set of new search results satisfying the first query, and the search results of the first set that were saved in association with the first query. We have not added any new matter. Claim 42 is enjoys similar support in the specification and drawings as the existing claims.

CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art. We kindly request favorable reconsideration and allowance of this application.

FEES

Applicant does not believe that filing of this Amendment will incur additional fees. However, the Commissioner is authorized to charge any fees due to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862.

Respectfully Submitted,

Michael Glenn
Reg. No. 30,176

Customer 22,862

10/719,483